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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,122

Applicant(s)

IKEDA ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-20 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on December 20, 2005, amended claims 1, 8 and 10-12; canceled claims 2-7; and new claims 13-24 are acknowledged. The *objection* to the specification is *withdrawn*. The current rejections of claims 10-12 are *withdrawn*. The current rejections of claims 1 and 8-9 *stand*. The following new and reiterated grounds of rejection are set forth:

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the buffering member must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "connecting member" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,982,725 to Hibino et al.

In regard to claim 10-12, Hibino et al. disclose an electric bending endoscope comprising bending driving unit which bends a bending portion 508 arranged to an edge side of an inserting portion thereof wherein the bending driving unit comprises at least

two detachable units of: a frame unit 663 which holds a motor 686 as a driving source for bending the bending portion; and a bending and stretch mechanism unit 503 separable from the frame unit which has a driving force transmitting member 510 for bending the bending portion by using rotation driving force from the motor, and wherein an outer member of the inserting portion, a universal cord, and necessary switches 694 for operating the operations of the electric bending endoscope are connected to the frame unit via an mediating member (see Fig 18 and Col. 46, Line 40 – Col. 47, Line 67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 13, 15-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 4,982,725 to Hibino et al. in view of U.S. Patent No. 6,793,622 to Konomura et al.

In regard to claims 1 and 18, Hibino et al. disclose an electric bending endoscope comprising: a bending portion arranged to an inserting portion; a unit which holds a motor, that generates driving force for bending the bending portion, a first unit which holds the motor, and a second unit which includes a driving force transmitting member that transmits the driving force of the motor to bend the bending portion by the driving force of the motor (see Fig. 1 and 18); but are silent with respect to a buffering

Art Unit: 3739

member which connects the first unit to an outer member of the inserting portion, a connecting code, and a switch arranged to the electric bending endoscope, the buffering member absorbing external force generated during the operation of the electric bending endoscope. Konomura et al. teach of an analogous electric bending endoscope having a buffering member with a predetermined hardness located in the pulley 34 rotatably as shown in Fig 7a (see Col. 8, Lines 39-65) and can inherently be positioned in a variety of positions so as to maximize the amount of force absorption. It would have been obvious to one skilled in the art at the time the invention was made to include a buffering material in the apparatus of Hibino et al. in order to absorb any external forces generated during operation of the endoscope as taught by Konomura et al.

In regard to claim 13, Hibino et al. disclose an electric bending endoscope, wherein the unit comprises a frame unit as a hard member 663 for holding the motor (see Fig. 18).

In regard to claims 15-17, Hibino et al. disclose an electric bending endoscope, wherein the operating portion is provided with a switch for operating the electric bending endoscope (see Col. 46, Line 40 – Col. 47, Line 67).

In regard to claims 19-20, Hibino et al. disclose an electric bending endoscope, further comprising: a fixing member which fixes the inner frame of the first unit and a main frame arranged to the second unit (see Fig. 1 and 18).

In regard to claim 22, Hibino et al. disclose an electric bending endoscope, wherein a wheel is arranged to a driving shaft of a driving force transmitting member of

Art Unit: 3739

the second unit, and a rotating shaft of the wheel is arranged in front of the operating portion on a side cross-section of the operating portion in the electric bending endoscope, with respect to the central axis of the inserting portion (see Figs 1 and 34).

Claims 8-9 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 4,982,725 to Hibino et al. in view of U.S. Patent No. 6,793,622 to Konomura et al. in further view of U.S Patent No. 5,609,563 to Suzuki et al.

In regard to claims 8-9, and 23-24, Hibino et al. and Konomura et al. disclose an electric bending endoscope having an operation lever 16 arranged to the operating portion for operating the bending driving unit, but are silent with respect to an angle formed between the center axis of the inserting portion in the electric bending endoscope and the center axis of the operation lever at the neutral position thereof, and the angle is (120-150 degrees), an inclined angle of the operation lever is +/- 30 degrees from the center of the operation lever, and the inclined center position of the operation lever is arranged in front of the operating portion, with respect to the center position of the inserting portion in the electric bending endoscope. Suzuki et al teach of an analogous electric bending endoscope wherein the operating portion of the endoscope is formed between the center axis of the inserting portion and the center axis of the operation lever as seen in Figs. 1 and 4. It would have been obvious to one skilled in the art at the time the invention was made to construct the operating portion of the apparatus of Hibino et al. and Konomura et al. at an angle in order to provide a more comfortable fitting during use for the operator of the instrument as taught by Suzuki et al.

Allowable Subject Matter

Claim 21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed December 20, 2005 have been fully considered but they are not persuasive.

Applicant states that Konomura fails to disclose a buffering member that absorbs external force applied to at least one of the inserting portion, the operating portion or the connecting cord that is connected to the first unit. However, Konomura et al. teach of an analogous electric bending endoscope having a buffering member with a predetermined hardness located in the pulley 34 rotatably as shown in Fig 7a (see Col. 8, Lines 39-65) and can inherently be positioned in a variety of positions so as to maximize the amount of force absorption. Thus, as broadly as claimed, the buffering member absorbs external force applied to the operating portion since the buffering material is associated with pulley 34 and bending wires 33, which in part comprise the operating system of the endoscope of Konomura et al.

Applicant states that Hibino does not disclose a first unit holding the motor and a second unit having a force-transmitting member. However, as seen in Figure 18, Hibino disclose a first unit 663 housing motors 685 and 686 and a second unit 503 housing force-transmitting members 510 and 513.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *mk*

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